

consumption, wherein said selection of said file does not involve an online session with a goods or services provider” in claim 8, and the limitation “monitoring, by the first device, consumption of digital content of the stored digital content files, which are selected from the digital content storage for consumption, wherein said selection of said file does not involve an online session with a goods or services provider” in claim 14.

Support for this amendment can be found in the Specification in Figures 2 and 3 and ¶¶ [0031]-[0033] and [0037]. Specifically, ¶ [0037] states that “if the computer 12(1) does not have access to the network 24, then the NO branch is followed and steps 200-500 are repeated”. While the language of ¶ [0037] is not literally identical with the added claim limitation of “wherein said selection of said file does not involve an online session with a goods or services provider” of claims 1, 8, and 14, the element of “an online session with a goods or services provider” is synonymous with the language “does not have access to the network 24” as is disclosed in the Specification.

The Examiner has rejected this claim amendment by stating “the newly added negative limitations appear to negate features which are required limitations”. The Examiner states “[s]ince the specification contains no discussion of what constitutes of online sessions, these sessions could be interpreted as referring to the communications between the claimed first device and the claimed digital content storage. Additionally, the first device is in fact a service provider since it provides digital content for consumption.” Applicants respectfully disagree.

With respect to Examiner’s statement that “the specification contains no discussion of what constitutes of on-line sessions, these sessions could be interpreted as referring to the communications between the claimed first device and the claimed digital content storage”, Applicants respectfully disagree. As noted above, the claim element “wherein said selection of said file does not involve an online session with a goods or services provider” of claims 1, 8, and 14 is described in the Specification using the synonymous language “does not have access to the network 24” of ¶ [0037]. Thus, it is clear that the Specification describes an online session to be synonymous to having access to the network 24.

Additionally, with respect to the Examiner’s assertion that “the first device is in fact a service provider since it provides digital content for consumption”, Applicants

also respectfully disagree. As shown in Figures 1 and 3 and described in ¶¶ [0018], [0028], and [0030]-[0037], a goods or services provider is defined to be a remote content provider server 18 connected to the computer 12(1) or audio player 16 by the network 24. In conclusion, as described in the Specification, computer 12(1) must have access to the network 24 to access the content provider 18 in step 100, but does not need to have access to the network 24 for steps 200-500, the steps of monitoring, using/consuming content, and storing usage information about the using/consuming.

In conclusion, the Examiner asserts that the claim element “wherein said selection of said file does not involve an online session with a goods or services provider” of claims 1, 8, and 14 “appear[s] to negate features which are required limitations”. However, Applicants respectfully submit that the claim element does not negate features that are required limitations, but merely clarify the claimed invention by limiting the present invention to one in which files are selected on the first device without accessing the network. Accordingly, in view of the foregoing remarks, the Office is respectfully requested to reconsider and withdraw the rejections of claims 1, 8, and 14.

Similarly, because claims 2-7, 9-13, 15-19, and 21-28 depend from claims 1, 8, and 14, Applicants respectfully request the rejection of these claims be withdrawn.

#### **USC 112 Rejection**

Claims 1-19 and 21-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants respectfully traverse.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use

the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The Examiner rejects claims 1, 8 and 14 as reciting a negative limitation which calls for the selection of a file that “...does not involve an online session with a goods or service provider.” The Examiner asserts that the original disclosure contains no suggestion of such an exclusion, and therefore the exclusion is new matter. Applicants respectfully disagree.

MPEP 2173.05(i) states that:

Any negative limitation or exclusionary proviso must have basis in the original disclosure. The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a prima facie case for lack of descriptive support. (Emphasis added.)

As above, Applicants respectfully submit that the claim limitation is supported by the Specification. The claim limitation “a monitoring system that monitors, at the first device, consumption of digital content of a file selected from the digital content storage, and generates usage data based on one or more usage events and indicative of the manner in which the digital content is consumed, wherein said selection of said file does not involve an online session with a goods or services provider” in claim 1, the limitation “monitoring, by the first device, consumption of digital content of the stored digital content files, which are selected from the digital content storage for consumption, wherein said selection of said file does not involve an online session with a goods or services provider” in claim 8, and the limitation “monitoring, by the first device, consumption of digital content of the stored digital content files, which are selected from the digital content storage for consumption, wherein said selection of said file does not involve an

online session with a goods or services provider” in claim 14 are supported in the Specification.

Support for this amendment can be found in the Specification in Figures 1-3 and ¶¶ [0018], [0028], [0030]-[0033], and [0037]. Specifically, ¶ [0037] states that “if the computer 12(1) does not have access to the network 24, then the NO branch is followed and steps 200-500 are repeated”. While the language of ¶ [0037] is not literally identical with the added claim limitation of “wherein said selection of said file does not involve an online session with a goods or services provider” of claims 1, 8, and 14, the element of “an online session with a goods or services provider” is synonymous with the language “does not have access to the network 24” as is disclosed in the Specification.

Applicants respectfully submit that the claim limitation of “wherein said selection of said file does not involve an online session with a goods or services provider” of claims 1, 8, and 14 is not new matter and complies with the written description requirement of 35 U.S.C. 112, first paragraph. Accordingly, in view of the foregoing remarks, the Office is respectfully requested to reconsider and withdraw the rejections of claims 1, 8, and 14.

Similarly, because claims 2-7, 9-13, 15-19, and 21-28 depend from claims 1, 8, and 14, Applicants respectfully request the rejection of these claims be withdrawn.

#### **USC 103(a) Rejection**

Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (U.S. Patent No. 6,466,915) in view of Henrick (U.S. Patent No. 6,507,727). Applicants respectfully traverse.

With respect to claims 20-22, the Examiner states that “Figure 1 of the Suzuki patent illustrates a first device in the form of a terminal 100, and that the terminal is a computer terminal and thus inherently includes a digital content storage system in the form of an internal memory. The graphical user interface of Figure 25 is a monitoring system that appears on the terminal and monitors the selection of specific files, such as the selection of “flower pattern one-piece dress”. Making the selection generates usage data, such as color, size, price and quantity purchased, which are subsequently sent to the central processing center (100) in Fig. 1. The data fields, such as the data fields

containing the named color “pink” and the price “6.800” are the usage data storage system since these fields store the usage data until it is sent to the central processing center (100) in Fig. 1. FIG.11 illustrates a table which forms the usage metrics system. The table permits inferenced conclusions, such as the conclusion that a customer prefers a particular size, as illustrated at C in FIG. 7C and described at col. 18, lines 1-6. The table of FIG. 11 is located in the order reception file (3) (col. 13, lines 66-67) which is part of the central processing center (100) and forms a second device remote from the first device (terminal 200). FIGS. 5A-5C of Henrick illustrate a portable device which can download digital audio content, such as a song file (“download song”). The portable device is thus a digital audio player. The digital content can be purchased (abstract, line 1). It would have been obvious to one of ordinary skill in the art to modify the terminal (200) of Suzuki et al. to be a portable cellular terminal configured to additionally download audio content as taught by Henrick so as to permit portability of the terminal and permit both physical items (clothing) and digital content (songs) to be purchased from the same system.” Applicants respectfully disagree.

Applicants respectfully submit that Suzuki neither discloses nor suggests “a monitoring system that monitors, at the first device, consumption of digital content comprising an audio file selected from the digital content storage, and generates usage data based on one or more usage events and indicative of the manner in which the digital content is consumed”, as is recited in claim 20.

The Examiner asserts that viewing a website corresponds to Applicants’ “monitor[ing] consumption of digital content”, and that selecting data such as color, size, price and quantity purchased corresponds to Applicants’ “generat[ing] usage data based on one or more usage events and indicative of the manner in which the digital content is consumed”, as is recited in claim 20. Applicants respectfully disagree.

Applicants respectfully submit that Suzuki’s viewing of a website is dissimilar to Applicant’s consumption of digital content. The claim limitation “generat[ing] usage data based on one or more usage events and indicative of the manner in which the digital content is consumed”, as is recited in claim 20, makes clear that consumption of digital content provides usage data that includes usage events and data indicative of the manner in which the digital content is consumed. Suzuki’s viewing of a

website cannot provide usage data including usage events and data indicative of the manner in which the digital content is consumed, because viewing a website is a singular event that can only provide a single related datum. Viewing a website cannot provide data indicative of the manner in which the digital content is consumed, because a user can only view a website in a single manner, by viewing. No variations on consumption are possible when viewing a website.

Henrick does not remedy the shortcomings of Suzuki. Although Henrick describes a system that may facilitate the purchase and delivery of audio content over the Internet, there is no mention whatsoever in Henrick of “monitor[ing] consumption of digital content comprising an audio file selected from the digital content storage” or “generat[ing] usage data based on one or more usage events and indicative of the manner in which the digital content is consumed”, as is recited in claim 20. In Henrick, an audio file is downloaded from a remote source to a computer or portable device such as a cell phone or audio player. Henrick does not monitor the consumption of the audio file or generate usage data including usage events and indicating manner of consumption of the audio file, as is claimed.

Additionally, the Examiner does not make a prima facie case of obviousness. There is simply no teaching, suggestion or motivation within these references themselves to combine the various features disclosed therein in the manner recited in claim 20. Applicants respectfully request the Examiner clearly set forth the motivation to combine the references, without resorting to impermissible hindsight by referring to Applicants’ claimed invention.

Applicants respectfully submit that neither Suzuki nor Henrick teach, disclose or suggest the claim limitations of “monitor[ing] consumption of digital content comprising an audio file selected from the digital content storage” and “generat[ing] usage data based on one or more usage events and indicative of the manner in which the digital content is consumed”, as is recited in claim 20, and that neither Suzuki nor Henrick render claim 20 unpatentable. Accordingly, in view of the foregoing remarks, the Office is respectfully requested to reconsider and withdraw the rejections of claim 20.

With respect to claims 21 and 22, these claims depend from independent claim 1, which recites the limitation “a monitoring system that monitors, at the first

device, consumption of digital content of a file selected from the digital content storage, and generates usage data based on one or more usage events and indicative of the manner in which the digital content is consumed, wherein said selection of said file does not involve an online session with a goods or services provider".

As noted above, Suzuki's viewing of a website is dissimilar from the claimed "monitor[ing] consumption of digital content" and Suzuki's selecting data such as color, size, price and quantity purchased is dissimilar to the claimed "generat[ing] usage data based on one or more usage events and indicative of the manner in which the digital content is consumed". Also as noted above, Henrick also does not teach, disclose or suggest "monitor[ing] consumption of digital content" and "generat[ing] usage data based on one or more usage events and indicative of the manner in which the digital content is consumed".

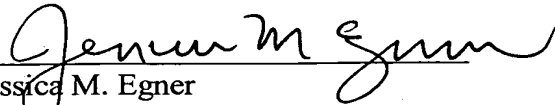
Additionally, Applicants respectfully submit that Suzuki does not disclose the added claim limitation "wherein said selection of said file does not involve an online session with a goods or services provider" of claim 1. In Suzuki, the purchasing transaction takes place entirely online, with a connection between the user's terminal and the remote computer. Similarly, in Henrick, the user selects an audio file to download from a remote server and downloads it, requiring a connection between the user's computer and a remote computer.

Applicants respectfully submit that neither Suzuki nor Henrick teach, disclose or suggest the claim limitation of "a monitoring system that monitors, at the first device, consumption of digital content of a file selected from the digital content storage, and generates usage data based on one or more usage events and indicative of the manner in which the digital content is consumed, wherein said selection of said file does not involve an online session with a goods or services provider", as is recited in independent claim 1, from which claims 21 and 22 depend, and that neither Suzuki nor Henrick render claims 21 and 22 unpatentable. Accordingly, in view of the foregoing remarks, the Office is respectfully requested to reconsider and withdraw the rejections of claims 21 and 22.

In view of the foregoing, it is submitted that the present application is in condition for allowance and a notice to that effect is respectfully requested. However, if

any issue remains after considering this response, the Examiner is invited to call the undersigned to expedite the prosecution and work out any such issue by telephone.

Respectfully submitted,

  
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